



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,698	06/30/2003	Hemingway Huynh	111255-135502	4440

25943 7590 08/07/2006

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

WON, MICHAEL YOUNG

ART UNIT PAPER NUMBER

2155

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,698	Applicant(s) HUYNH ET AL.	
	Examiner Michael Y. Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed June 19, 2006.
2. Claims 6 and 10 have been amended and claim 23 has been cancelled.
3. Claims 1-10 and 34 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 6 and 10 previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been, withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 23, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Tso et al. (US 6,247,050 B1).

INDEPENDENT:

As per **claim 1**, Tso teaches an article comprising:

a storage medium (see Fig.3, #30); and

instructions stored in the storage medium, which, when executed by a processor (see col.7, lines 61-67), cause the processor to generate one or more messages (see col.6, lines 40-62) including

logic for testing digital content capabilities of a receiving computer system (see col.4, lines 22-29 and col.5, lines 46-50); and

logic for displaying one of a plurality of versions of a digital content message selected based on the results of testing digital content capabilities of the receiving computer system (see Fig.2, #62; col.4, lines 36-38; and col.7, line 67-col.8, line 3), such that a receiving computer system may use the contents of the one or more messages to display the selected version of the digital content message (see col.6, lines 18-31 & 40-50).

As per **claim 6**, Tso teaches a method in a computing system for presenting an adaptive message, comprising:

receiving a message in the computer system (see col.5, lines 12-15); and

based on the contents of the received message (see col.6, lines 40-42):

testing two or more digital content capabilities of the computer system
(see col.4, lines 22-29 and col.5, lines 46-50);

selecting one of a plurality of different digital content elements based upon
the results of the testing (see col.6, lines 18-25 & 63-66); and

presenting the selected one of the plurality of digital content elements (see
Fig.2, #62; col.4, lines 36-38; and col.7, line 67-col.8, line 3).

As per **claim 34**, Tso teaches an article comprising:

a storage medium (see Fig.3, #30); and

instructions stored in the storage medium, which, when executed by a processor
(see col.7, lines 61-67), cause the processor to generate one or more messages (see
col.6, lines 40-62) including

logic for testing capabilities of a receiving computer system (see col.4, lines 22-
29 and col.5, lines 46-50); and

logic for displaying one of a plurality of versions of a message selected based on
the results of testing capabilities of the receiving computer system (see Fig.2, #62;
col.4, lines 36-38; and col.7, line 67-col.8, line 3), such that a receiving computer
system may use the contents of the one or more messages to display a version of the
message based upon capabilities of the receiving computer system (see col.6, lines 18-
31 & 40-50).

DEPENDENT:

As per **claim 2**, which depends on claim 1, Tso further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the *logic* is directly contained in the one or more messages (see col.6, lines 18-25 & 40-42).

As per **claim 3**, which depends on claim 1, Tso further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the *logic* is included in the message by reference (see col.6, lines 18-25 & 40-62).

As per **claim 4**, which depends on claim 1, Tso further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the *displayed version of the digital content message* is not directly included in the one or more messages, but is separately transferred under the control of the logic for displaying (see col.6, lines 18-25 & 40-42).

As per **claim 5**, which depends on claim 1, Tso further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the *displayed version of the digital content message* is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message (see col.6, lines 18-25 & 40-42).

As per **claim 7**, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a high-quality video sequence and a low-quality video sequence (see col.4, lines 19-29).

Art Unit: 2155

As per **claim 8**, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a video sequence and an animation sequence (see col.4, lines 19-29).

As per **claim 9**, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player (see col.4, lines 22-29).

As per **claim 10**, which depends on claim 6, Tso further teaches wherein the selected one of the digital content elements is selected based upon actions of a user of the computer system in connection with one or more messages received prior to said receiving of the message for presenting a digital content message (see col.7, lines 16-27 and col.9, lines 46-51).

Response to Arguments

6. Applicant's arguments filed June 19, 2006 have been fully considered but they are not persuasive.

The applicant(s) argue that Tso does not teach "instructions stored in the storage medium, which, when executed by a processor, cause the processor to generate one or more messages including logic for testing digital content capabilities of a receiving computer system".

Although *Tso* teaches of a remote scaling server 34 with a performance data collection module 60 (see Fig.2) that performs the testing, *Tso* also suggests an alternate embodiment. *Tso* suggests that the performance data collection module (PDC) 60 may be implemented as a software routine or as a separate executable module (see col.7, lines 61-67). Furthermore, *Tso* teaches that embedded instruction implemented as a dynamic executable module using JavaScript (see col.6, lines 25-31) is sent to the network client (see col.6, lines 40-42). Lastly, *Tso* “embraces all alternatives, modifications and variations” (see col.12, lines 30-33) that fall within the scope of the invention.

For this reason, a processor generating a message to test digital content capabilities of a receiving computer system is clearly taught and suggested.

It is noted that the features upon which applicant relies (i.e., “predetermined selection criteria related to the capabilities of the client are determined through testing logic that is **sent to the client**”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant(s) argue that *Tso* does not teach “based on the content of the received message, testing... selecting... and presenting”.

Clearly *Tso* teaches of testing... selecting... and presenting (see rejection above). Furthermore, *Tso* teaches of an executable message (see col.6, lines 25-31)

Art Unit: 2155

that is received at the client (see col.6, lines 40-42). Therefore, Tso teaches all the limitations of claim 6.

For the reasons above claims 1-10 and 34 remain rejected and pending.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

Art Unit: 2155

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won



August 3, 2006



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER